

Serial No. 09/714,018
Reply to Examiner's Answer dated May 28, 2009
Page 1 of 21

RECEIVED
CENTRAL FAX CENTER

JUL 28 2009

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Before The Board of Patent Appeals and Interferences

Applicant:	Harry Thomas Kloor	
Serial No.:	09/714,018	Conf. No.: 5553
Filing Date:	November 16, 2000	Group Art Unit: 3627
Title:	DUAL TRANSACTION AUTHORIZATION SYSTEM AND METHOD	Examiner: Maria Teresa T. Thein
Docket No:	18822-11	

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANTS' REPLY BRIEF UNDER 37 C.F.R. §41.41

In response to the Examiner's Answer dated May 28, 2009, Appellants timely submit this Reply Brief under C.F.R. §41.41 within two months of the Examiner's Answer, this Brief being filed on July 28, 2009 in accordance with 37 C.F.R. §1.7(a)).

Serial No. 09/714,018
Reply to Examiner's Answer dated May 28, 2009
Page 2 of 21

(1) STATUS OF CLAIMS

Claims 18-28 and 30-57 are pending and are herein appealed. Claims 49-50 are withdrawn, and claims 1-17, 29, and 58-62 are cancelled.

Claim 53 has been rejected pursuant to 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

Claims 42-43, 45-46 and 51-54 have been rejected pursuant to 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,621,201 to *Langhans et al.*

Claims 18, 20-28, 30-33, 36-37 and 56 have been rejected pursuant to 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,529,725 to *Joao et al.* in view of PCT World Publication No. WO 96/32700 to *Jonstromer*.

Claims 19, 39, 40 and 57 have been rejected pursuant to 35 U.S.C. §103(a) as being unpatentable over *Joao et al.* and *Jonstromer* and further in view of U.S. Patent No. 5,845,267 to *Ronen*.

Claim 34 has been rejected pursuant to 35 U.S.C. §103(a) as being unpatentable over *Joao et al.* and *Jonstromer* in further view of U.S. Patent No. 5,748,783 to *Rhoads*.

Claim 35 has been rejected pursuant to 35 U.S.C. §103(a) as being unpatentable over *Joao et al.* and in further view of *Langhans et al.*

Claim 38 has been rejected pursuant to 35 U.S.C. §103(a) as being unpatentable over *Joao et al.* in view of *Jonstromer* as applied to claim 36 above, and further in view of Official Notice.

Claims 41 and 55 have been rejected pursuant to 35 U.S.C. §103(a) as being unpatentable over *Langhans et al.* in view of *Joao et al.*

Claim 44 has been rejected pursuant to 35 U.S.C. §103(a) as being unpatentable over *Langhans et al.* in view of *Ronen*.

Claim 47 has been rejected pursuant to 35 U.S.C. §103(a) as being unpatentable over *Langhans et al.* in view of *Jonstromer*.

Serial No. 09/714,018
Reply to Examiner's Answer dated May 28, 2009
Page 3 of 21

Claim 48 has been rejected pursuant to 35 U.S.C. §103(a) as being unpatentable over
Langhans et al. in view of *Rhoads*.

Serial No. 09/714,018
Reply to Examiner's Answer dated May 28, 2009
Page 4 of 21

(2) GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 42-43, 45-46, and 51-54 are rejected under 35 U.S.C. § 102(b), Claims 18-28, 30-41, 44, 47-48, and 55-57 are rejected under 35 U.S.C. § 103. Claims 18-28, 30-48, 51-57 are appealed herein. The grounds of rejection to be reviewed on appeal are as follows:

A. Whether the Examiner has established a *prima facie* case that claim 18 is unpatentable under 35 U.S.C. §103(a) as being obvious over Joao et al. (U.S. Patent No. 6,529,725) in view of PCT World Publication No. WO 96/32700 to Jonströmer?

B. Whether the Examiner has established a *prima facie* case that claim 30 is unpatentable under 35 U.S.C. §103(a) as being obvious over Joao et al. (U.S. Patent No. 6,529,725) in view of PCT World Publication No. WO 96/32700 to Jonströmer?

C. Whether the Examiner has established a *prima facie* case that claim 36 (former now includes all of former 18) is unpatentable under 35 U.S.C. §103(a) as being obvious over Joao et al. (U.S. Patent No. 6,529,725) in view of PCT World Publication No. WO 96/32700 to Jonströmer?

D. Whether the Examiner has established a *prima facie* case that claim 37 is unpatentable under 35 U.S.C. §103(a) as being obvious over Joao et al. (U.S. Patent No. 6,529,725) in view of PCT World Publication No. WO 96/32700 to Jonströmer?

E. Whether the Examiner has established a *prima facie* case that claim 38 is unpatentable under 35 U.S.C. §103(a) as being obvious over Joao et al. (U.S. Patent No. 6,529,725) in view of PCT World Publication No. WO 96/32700 to Jonströmer, and further in view of Official Notice?

F. Whether the Examiner has established a *prima facie* case that claim 56 is unpatentable under 35 U.S.C. §103(a) as being obvious over Joao et al. (U.S. Patent No. 6,529,725) in view of PCT World Publication No. WO 96/32700 to Jonströmer?

G. Whether the Examiner has established a *prima facie* case that claim 39 is unpatentable under 35 U.S.C. §103(a) as being obvious over Joao et al. and PCT World

Serial No. 09/714,018
Reply to Examiner's Answer dated May 28, 2009
Page 5 of 21

Publication No. WO 96/32700 to Jonströmer and further view of Ronen (U.S. Patent No. 5,845,267)?

H. Whether the Examiner has established a *prima facie* case that claim 40 is unpatentable under 35 U.S.C. §103(a) as being obvious over Joao et al. and PCT World Publication No. WO 96/32700 to Jonströmer and further view of Ronen (U.S. Patent No. 5,845,267)?

I. Whether the Examiner has established a *prima facie* case that claim 41 is unpatentable under 35 U.S.C. §103(a) as being obvious over Langhans et al. (U.S. Patent No. 5,621,201) in view of Joao et al. (U.S. Patent No. 6,529,725)?

J. Whether claim 42 is unpatentable under 35 U.S.C. §102(b) as being fully anticipated by Langhans et al. (U.S. Patent No. 5,621,201)?

Serial No. 09/714,018
Reply to Examiner's Answer dated May 28, 2009
Page 6 of 21

(3) ARGUMENTS

(A) CLAIM 18 IS PATENTABLE OVER JOAO ET AL. IN VIEW OF JONSTRÖMER

Appellants argued that the cited references do not teach, suggest, or otherwise render obvious at least the following claimed steps "monitoring the owner to determine the latest contact information" and "using the latest contact information from said monitoring to electronically send the request to the owner from the authorization agent," and that Claim 18 is patentable over Joao et al. in view of Jonströmer. Appeal Brief, 2/16/2009, pp. 8-10. In response, Examiner asserted:

Joao discloses an apparatus which comprises a cardholder communication device which received signals and/or data from either or both of the point-of-sale terminal and/or the central processing compute (col. 14, lines 18-21). Joao discloses the activation of the apparatus by obtaining a phone line and entering card information into the point of sale terminal in order to start a transaction (col. 17, lines 4-8).

Examiner's Answer, 5/28/2009, p. 13. However, this teaching clearly fails to teach or suggest monitoring the owner "to determine the latest contact information" or "using the latest contact information from said monitoring to electronically send the request to the owner from the authorization agent" as claimed. Although Joao may describe activation by obtaining a phone line, this teaching at most describes acquiring contact information. Yet, "acquiring a contact information that is unique to an owner" is a distinct and separately recited step of claim 18. Nowhere does the teaching identified by Examiner teach or suggest: "monitoring the owner to determine the latest contact information" and "using the latest contact information from said monitoring to electronically send the request to the owner from the authorization agent" as distinct steps from "acquiring a contact information that is unique to an owner" as claimed.

The Examiner goes on to assert:

Moreover, Joao discloses the providing of self-monitoring functions, automatic control and/or responses to occurrences, automatic notice of an occurrence and/or a situation, to an owner, user and/or authorized individual.

Examiner's Answer, 5/28/2009, p. 14. However, as previously noted by Appellants in the Appeal Brief, this teaching from the Joao reference plainly refers to entirely distinct functionality

Serial No. 09/714,018
Reply to Examiner's Answer dated May 28, 2009
Page 7 of 21

than that claimed in Claim 18. Joao describes hardware and software for self-monitoring, automatic control, and responses to occurrences, and functionality for automatic notice to the owner or user, which allows for detecting an occurrence or situation and providing notice to the cardholder. Nowhere does this disclosure teach or suggest monitoring the owner "to determine the latest contact information" or "using the latest contact information from said monitoring to electronically send the request to the owner from the authorization agent" as claimed. Merely because Joao employs the word "monitor" does not render Appellants "monitoring" step obvious.

Finally, the Examiner also asserts:

Such apparatus which comprises a cardholder communication device which receives signals and/or data from either or both of the point-of-sale terminal and/or the central processing computer; central processing computer processing the information and/or data pertinent to the transaction in conjunction with the card account information to determine the status of the card account; central processing computer transmits a signal and/or data to the communication device which is located at the cardholder; information and/or data which is transmitted to the communication device includes information and/or data identifying the transaction and may include the name of the store or the service provider and the amount of the transaction, and the phone number of the central processing office and/or computer servicing the account so that the cardholder may telephone in order to authorize or cancel the transaction; information and/or data which is transmitted from the central processing computer and received at the communication device are displayed to the cardholder on the display device of the communication device; self-monitoring functions, automatic control and/or responses to occurrences, automatic notice of an occurrence and/or a situation, to an owner, user and/or authorized individual; monitoring device, triggering device and/or any other suitable device for detecting an occurrence and/or a transaction may warrant providing notice to the respective cardholder, account owner and/or cellular telephone owner; and apparatus is designed or programmed to telephone the cardholder, account owner and/or cellular telephone owner and/or authorized individual at a primary phone number, at an alternate or forwarding phone number, and/or at a business phone number, send a beeper or pager message to the individual, and/or send a fax message, an electronic mail message, a voice mail message and/or answering service message to or for the card holder, account owner and/or cellular telephone owner or authorized individual so as to provide and to ensure that best efforts are to be made to communicate with the desired

Serial No. 09/714,018
Reply to Examiner's Answer dated May 28, 2009
Page 8 of 21

individual as soon as possible are considered "monitoring the owner to determine the latest contact information or using the latest contact information from said monitoring to electronically send the request to the owner from the authorization agent".

Examiner's Answer, 5/28/2009, p. 16. The foregoing quote appears to be a litany of recitations relating to the teachings of Joao. However, it is not clear how they result in the conclusion reached by Examiner that they are considered "monitoring the owner to determine the latest contact information or using the latest contact information from said monitoring to electronically send the request to the owner from the authorization agent." To the contrary, nothing cited or argued in the Examiner's Answer teach or suggest monitoring the owner "to determine the latest contact information" or "using the latest contact information from said monitoring to electronically send the request to the owner from the authorization agent" as claimed. Accordingly a *prima facie* case of obviousness has not been established.

(B) CLAIM 30 IS PATENTABLE OVER JOAO ET AL. IN VIEW OF JONSTRÖMER

Appellants argued that the cited references do not teach, suggest, or otherwise render obvious "wherein the latest contact information is an Internet address where the owner is conducting the transaction" and that Claim 30 is patentable over Joao et al. in view of Jonströmer. Appeal Brief, 2/16/2009, pp. 10-11. Moreover, the Examiner asserted: "[T]he combination [of Joao and Jonströmer] does not explicitly disclose requiring Internet or IP address." 6/13/2008 Office Action, p. 9.

In response, Examiner asserted:

Examiner notes that every computer has an Internet address in order to communicate with other computers within a network. The Internet address, which is a number or name, identifies the computer uniquely among all the computers on the network, in order for a computer to exchange data and files or send and receive messages with other computers on the network. A computer can only exchange data and files or send and receive messages to another computer if it knows that computer's Internet address. In Joao, an Internet address must be used to transmit data to the communication device of the cardholder (col. 18, lines 19-21).

Serial No. 09/714,018
Reply to Examiner's Answer dated May 28, 2009
Page 9 of 21

Examiner's Answer, 5/28/2009, p. 16-17. Appellants cannot agree. As an initial matter, Examiner's assertion that "every computer has an Internet address" is demonstrably untrue. Moreover, although Internet addresses are ubiquitous today, Appellants note that during prosecution of the present application Appellants established conception of the present invention at least as early as October 4, 1007, and Joao and Jonströmer have priority dates of August 8, 1996 and April 11, 1995 respectively. Neither the references nor the state of the art as of those priority dates support the assertion that "every computer has an Internet address."

Further, Examiner's statement that "A computer can only exchange data and files or send and receive messages to another computer if it knows that computer's Internet address" and "In Joao, an Internet address must be used to transmit data to the communication device of the cardholder (col. 18, lines 19-21)" are also unsupported by the art and unpersuasive. At this citation, Joao merely states: "...the central processing computer 3 will, at step 37, transmit a signal and/or data to the communication device 4 which is located at the cardholder." Col. 18, lines 19-21. This teaching discloses *that* a signal is transmitted but it clearly does not disclose *how* or through *what* communication channel the signal is transmitted.

Appellants respectfully point out that Joao clearly discloses another network that it uses for communications rather than the Internet and Internet addresses. Joao plainly teaches: "The point-of-sale terminal is linked and/or connected to the central processing computer via a communications system, link and/or medium, such as, for example, a telephone network or line." (emphasis added) Col. 4, lines 35-38. Indeed, nowhere does either the Joao reference nor the Jonströmer reference provide any discussion whatsoever relating to Internet addresses or monitoring Internet addresses as claimed.

For at least these reasons, the rejection fails to establish a *prima facie* case of obviousness, and Claim 30 is non-obvious and patentable over Joao and Jonströmer.

(C) CLAIM 36 IS PATENTABLE OVER JOAO ET AL. IN VIEW OF JONSTRÖMER

Serial No. 09/714,018
Reply to Examiner's Answer dated May 28, 2009
Page 10 of 21

Appellants argued that the cited references do not teach, suggest, or otherwise render obvious at least the following claimed step "providing a PIN number that is unique to the owner from a remote site to establish a different contact information to the remote site," and that Claim 36 is patentable over Joao et al. in view of Jonströmer. Appeal Brief, 2/16/2009, pp. 11-13. In response, Examiner asserted:

The combination of Joao and Jonstromer teaches or suggests the recitation above. Joao teaches the communication device is utilized to change a personal identification number or access code (claim 132). The personal identification number and access code can be specified and programmed to be changed and provide for various personal identification numbers and/or access codes for different locations, different days, different times and/or different transaction amounts (col. 42, lines 56-62) Jonstromer teaches an electronic transaction terminal comprising a smart card and mobile phone operating in combination (page 7, lines 18-20). When a transaction is to be initiated, the smart card which holds cash credits and acts as an electronic wallet, is inserted into the mobile phone. The user enters his PIN and a phone number for the payee's electronic till together with an amount to be transferred. (Page 8, lines 1-6)

Such communication device which is utilized to change a personal identification number or access code; personal identification number and access code can be specified and programmed to be changed and provide for various personal identification numbers and/or access codes for different locations, different days, different times and/or different transaction amounts; and transaction initiated by the user entering his PIN are considered "providing a PIN number that is unique to the owner from a remote site to establish a different contact information to the remote site".

Examiner's Answer, 5/28/2009, pp. 18-19. Appellants disagree and assert that Examiner's conclusion is a non sequitur. Starting with the teaching of Joao, Examiner asserts that the reference discloses, "The personal identification number and access code can be specified and programmed to be changed and provide for various personal identification numbers and/or access codes for different locations, different days, different times and/or different transaction amounts (col. 42, lines 56-62)." The appearance of the word "location" may have been misleading, but this teaching clearly refers to establishing different PIN numbers for different automated teller machines. See, Joao, Col. 42, lines 56-62 ("With regards to automated teller machine accounts, it is also possible to specify and programmably change personal identification

Serial No. 09/714,018
Reply to Examiner's Answer dated May 28, 2009
Page 11 of 21

numbers...and provide for various personal identification numbers...for different locations.”). However, this is entirely distinct from the claimed limitation “providing a PIN number that is unique to the owner from a remote site to establish a different contact information to the remote site.”

Regarding the additional teachings and combinations thereof from the Jonströmer reference, Appellants agree that the reference discloses “When a cash transaction is to be initiated, the smart card, which holds cash credits and acts as an electronic wallet, is inserted into the mobile phone, and the user enters his PIN and a phone number for the payee’s electronic till 4, together with an amount to be transferred...” Page 8, lines 1-6. However, nowhere does this teaching, even in combination with the teachings of Joao, render obvious “providing a PIN number that is unique to the owner from a remote site to establish a different contact information to the remote site” as claimed.

The cited references simply do not make obvious “providing a PIN number that is unique to the owner from a remote site” to achieve a specific function — namely, “to establish a different contact information to the remote site” — as claimed. The rejection fails to establish a *prima facie* case of obviousness, and Claim 36 is non-obvious and patentable over Joao and Jonströmer.

(D) CLAIM 37 IS PATENTABLE OVER JOAO ET AL. IN VIEW OF JONSTRÖMER

Appellants argued that the cited references do not teach, suggest, or otherwise render obvious the method of claim 36 “wherein the remote site is away from the owner’s home,” and that Claim 37 is patentable over Joao et al. in view of Jonströmer. Appeal Brief, 2/16/2009, pp. 13-14. In response, Examiner asserted:

Joao teaches the communication device is utilized to change a personal identification number or access code (claim 132). The personal identification number and access code can be specified and programmed to be changed and provide for various personal identification numbers and/or access codes for different locations, different days, different times and/or different transaction amounts (col. 42, lines 56-62) Jonstromer

Serial No. 09/714,018

Reply to Examiner's Answer dated May 28, 2009

Page 12 of 21

teaches an electronic transaction terminal comprising a smart card and mobile phone operating in combination (page 7, lines 18-20). When a transaction is to be initiated, the smart card which holds cash credits and acts as an electronic wallet, is inserted into the mobile phone. The user enters his PIN and a phone number for the payee's electronic till together with an amount to be transferred. (Page 8, lines 1-6) Furthermore, Jonstromer teaches that the electronic transaction terminal can be used to conduct local electronic credit transfer in a shop or restaurant, payment for a parking fee at an unattended car lot or parking meter (page 10, lines 18-22).

Examiner's Answer, 5/28/2009, pp. 19-20. The Examiner goes on to assert that the forgoing teaching renders obvious the method of claim 36 "wherein the remote site is away from the owner's home," but there is no explanation as to how or why a person having ordinary skill in the art would arrive at this claim limitation from the recited teachings.

After reiterating the same teachings from Joao that were cited against claim 36, the crux of the Examiner's argument appears to rely on the teaching from Jonströmer: "Jonstromer teaches that the electronic transaction terminal can be used to conduct local electronic credit transfer in a shop or restaurant, payment for a parking fee at an unattended car lot or parking meter." Examiner's Answer, 5/28/2009, p. 20. However, this is not persuasive. The question is not whether the invention may be used to conduct electronic credit transfers at a location away from home, such as in a shop or restaurant as disclosed by Jonströmer.

Rather, the issue is whether the references render obvious providing a PIN "to establish a different contact information to the remote site" where "the remote site is away from the owner's home." Clearly they do not, as nothing in the foregoing would teach, suggest, or otherwise make obvious these limitations. Jonstromer's discussion of conducting electronic credit transfers at a location away from home plainly falls short of establishing a *prima facie* case of obviousness with respect to claim 37.

(E) CLAIM 38 IS PATENTABLE OVER JOAO ET AL. IN VIEW OF JONSTRÖMER AND OFFICIAL NOTICE

Appellants argued that the cited references do not teach, suggest, or otherwise render obvious "A method according to claim 36, wherein the different contact information is only

Serial No. 09/714,018
Reply to Examiner's Answer dated May 28, 2009
Page 13 of 21

established for a predetermined amount of time" and that Claim 38 is patentable over Joao et al., Jonströmer, and further in view of Official Notice. Appeal Brief, 2/16/2009, pp. 14-15. In response, Examiner asserted:

Examiner does not agree. The combination of Joao and Jonstromer teaches or suggests the recitation above.

Examiner's Answer, 5/28/2009, pp. 20-22. The Examiner goes on to assert that Joao and Jonströmer make this limitation obvious. Appellants respectfully disagree and require clarification.

The rejection plainly states that Claim 38 is rejected pursuant to 35 U.S.C. §103(a) as being unpatentable over *Joao et al.* in view of *Jonstromer* as applied to claim 36 above, and further in view of Official Notice. See, 6/13/2008 Office Action, p. 11. However, now the Examiner asserts that Joao and Jonströmer alone, without the Official Notice, render claim 38 obvious. It is unclear to Appellants whether the Examiner is asserting a new grounds of rejection. Insofar as the rejection articulated in the 6/13/2008 Office Action is still the rejection of record, Appellants reiterate the arguments in the 2/16/2009 Appeal Brief at pages 14-15 that establish that the Official Notice is lacking.

However, insofar as the Examiner is asserting a new rejection to claim 38 based only on Joao and Jonströmer, Appellants respectfully note that the Final Office Action plainly acknowledges that the combination of the Joao reference and the Jonströmer reference does not disclose "that contact information is only established for a predetermined amount of time." See, 6/13/2008 Office Action, p. 11. Moreover, although Examiner cites Joao as disclosing various piecemeal steps of determining whether a response is made by a cell phone user in a pre-defined period of time and a central processing computer canceling or deactivating a phone, these clearly are not on point for the limitations of Claim 36, which recites establishing "different contact information" for only a "predetermined amount of time."

The rejection fails to establish a *prima facie* case of obviousness for Claim 38.

(F) CLAIM 36 IS PATENTABLE OVER JOAO ET AL. IN VIEW OF JONSTRÖMER

Serial No. 09/714,018
Reply to Examiner's Answer dated May 28, 2009
Page 14 of 21

Claim 56 recites:

A method for *parties* to authenticate a transaction, comprising:
acquiring a corresponding contact information for each parties involved in a transaction;
providing an authorization agent to acquire the corresponding contact information,
wherein the authorization agent is a bank, a credit card company, or an agent of the bank or the credit card company; and
sending electronically an authorization request from the authorization agent to the corresponding contact information for each of the parties involved in the transaction, wherein:
approving the transaction if all of the parties to the transaction approve of the authorization request; and
disapproving the transaction if any of the parties to the transaction disapprove of the authorization request.

Appellants argued that the cited references do not teach, suggest, or otherwise render obvious "acquiring a corresponding contact information for each parties involved in a transaction" and approving the transaction "if all of the parties to the transaction approve of the authorization request" or disapproving the transaction "if any of the parties to the transaction disapprove of the authorization request". Appeal Brief, 2/16/2009, pp. 15-17.

In response, Examiner asserted:

Examiner does not agree. Joao discloses the apparatus comprises a central processing computer which services any predefined group of cellular telephones or cellular communication devices. The central processing computer can handle all cellular telephone accounts for a given telecommunication company and/or area. The central processing computer can process and maintain records of cellular telephone accounts and/or cellular telephone owners. (Col. 29, lines 25-35) Joao teaches the cellular telephone serves as a transaction terminal (col. 9, lines 26-28). Joao further teaches the method of monitoring the number of cellular or mobile telephone transactions which have [sic] unauthorized by the cellular or mobile telephone owner and to determine whether or not a central processing computer should cancel or de-activate the cellular telephone (col. 9, lines 58-63).

Examiner's Answer, 5/28/2009, pp. 22-23. The Examiner goes on to assert that the forgoing teaching renders obvious the foregoing limitations of claim 56. Applicants respectfully disagree.

Serial No. 09/714,018
Reply to Examiner's Answer dated May 28, 2009
Page 15 of 21

The Examiners point that "The central processing computer can handle all cellular telephone accounts for a given telecommunication company and/or area" appears to be misplaced. This assertion regarding Joao does not establish that each owner of a telephone account that is processed by the same computer is thereby a party to a specific transaction that will be approved or disapproved. Indeed, there is nothing else in Joao or Jonströmer that would suggest that these account holders are connected to the same transaction or that the approval of that transaction is contingent upon the approval each of the members of the parties.

The rejection fails to establish a *prima facie* case of obviousness for Claim 56.

(G) CLAIM 39 IS PATENTABLE OVER JOAO ET AL. IN VIEW OF JONSTRÖMER AND RONEN

Claim 39 recites:

A method for verifying that an authorized entity is using a credit card through the Internet, comprising:
entering a password that is known only to an authorized entity that can use a corresponding credit card;
monitoring the latest Internet address where the authorized entity is visiting through the Internet;
receiving a request to authorize a transaction from an Online business with a corresponding Internet address, wherein the request is received by an authorization agent, wherein the authorization agent is a bank that issued the credit card to the authorized entity, a credit card company, or an agent of the bank or the credit card company, and wherein the request includes a credit card number; and
comparing the latest Internet address with the corresponding Internet address from the Online business:
if the Internet addresses match, then sending from the authorization agent to the Online business an approval response to the request;
if the Internet addresses do not match, then sending from the authorization agent to the Online business a non-approval response to the request.

Appellants argued that Joao and Jonströmer do not teach, suggest, or otherwise render obvious all of the limitations of Claim 39. Appeal Brief, 2/16/2009, pp. 17-19. In response, Examiner asserted:

Serial No. 09/714,018

Reply to Examiner's Answer dated May 28, 2009

Page 16 of 21

Examiner notes that every computer has an Internet address in order to communicate with other computers within a network. The Internet address, which is a number or name, identifies the computer uniquely among all the computers on the network, in order for a computer to exchange data and files or send and receive messages with other computers on the network. A computer can only exchange data and files or send and receive messages to another computer if it knows that computer's Internet address. In Joao, an Internet address must be used to transmit data to the communication device of the cardholder (col. 18, lines 19-21). Joao discloses the communication device includes a personal computer, a telephone, a network computer, and a cellular telephone (col. 5, lines 7-11; col. 9, lines 13-25). Joao teaches that personal communication service systems and devices, including stationary, portable and/or handheld devices and digital signal communications systems and devices are also utilized (col. 10, lines 17-20). Furthermore, Joao discloses the apparatus and method may provide a transmission of any appropriate signal from a transmitter to the card holder, account owner and/or cellular, telephone owner. The, signal utilized could be in the form of a communication transmission, depending upon the communication medium utilized, a telephone call, an electronic mail message, and/or any other mode of communication which is utilized with any of the apparatuses, devices and/or components. (Col. 10, lines 42-52) A transmitter for transmitting the first signal over a communication network directly to a communication device associated with an individual account holder (abstract). The Examiner then cites Ronen to further teach the Internet addresses. Ronen teaches the billing for transactions conducted by a user through a terminal connected on a private Intranet with an ISP on the Internet which is affected by using the Connection ID to identify the particular connection established between the Firewall Gateway and the particular merchant ISP (col. 2, lines 26-31). The relationship between this Connection ID and IP address is transmitted to and received and stored by a Session Manager connected within the private Intranet network. The same Session Manager also receives and stores the relationship between the user's terminal IP address and the user's identity which is provided to the Session Manager when the user initiates a connection on the Intranet. (Col. 2, lines 36-41) The Connection ID comprises IP addresses associated with each end of the connection (col. 8, lines 66-67). When the user attempts to conduct a transaction with a merchant ISP on the public internet, a Billing Platform is queried by the merchant ISP before the transaction is effected. The Billing Platform uses the Connection ID associated with the particular connection over which the request for service, information, is being made, queries the Session Manager. The Session Manager thereupon translate that Connection ID to a corresponding IP address which, in turn, is translated into a user's ID from

Serial No. 09/714,018
Reply to Examiner's Answer dated May 28, 2009
Page 17 of 21

which the user's account is accessed at the Billing Platform. Once that user's account is accessed, authorization to proceed with the transaction is transmitted to the merchant ISP, which then completes the transaction. (Col. 2, lines 41 -54)

Such the billing for transactions conducted by a user through a terminal connected on a private Intranet with an ISP on the Internet which is affected by using the Connection ID to identify the particular connection established between the Firewall Gateway and the particular merchant ISP; relationship between the Connection ID and IP address is transmitted to and received and stored by a Session Manager connected within the private Intranet network; Session Manager which also receives and stores the relationship between the user's terminal IP address and the user's identity which is provided to the Session Manager when the user initiates a connection on the Intranet; Connection ID which comprises IP addresses associated with each end of the connection; user attempting to conduct a transaction with a merchant ISP on the public internet, a Billing Platform is queried by the merchant ISP before the transaction is effected; Billing Platform uses the Connection ID associated with the particular connection over which the request for service, information, is being made, queries the Session Manager; Session Manager thereupon translate that Connection ID to a corresponding IP address which, in turn, is translated into a user's ID from which the user's account is accessed at the Billing Platform; accessing the user's account, authorization to proceed with the transaction is transmitted to the merchant ISP, which then completes the transaction are considered "monitoring the latest Internet address where the authorized entity is visiting through the Internet..."; "receiving a request to authorize a transaction from an Online business with a corresponding Internet address..."; "comparing the latest Internet address with the corresponding Internet address from the Online business..."; and sending an approval "if the Internet addresses match" or sending a non-approval "if the Internet addresses do not match".

Examiner's Answer, 5/28/2009, p. 23-27. In response to Examiner's assertions regarding Internet addresses — e.g., "Examiner notes that every computer has an Internet address" and "A computer can only exchange data and files or send and receive messages to another computer if it knows that computer's Internet address" — these statements are plainly untrue, and Appellants incorporates the arguments made herein regarding Claim 30. See, Section (3)(B).

Regarding Examiner's additional arguments regarding the Ronen reference, although Ronen discusses IP addresses generally, the reference merely describes an identifier of the user's terminal not receiving the Internet address of the Online business or comparing the authorized

Serial No. 09/714,018
Reply to Examiner's Answer dated May 28, 2009
Page 18 of 21

entity's Internet address with that of the Online business as claimed. Appellants additional discussion of the Ronen reference from the Appeal Brief is hereby incorporated by reference. See Appeal Brief, 2/16/2009, pp. 18-19.

The rejection fails to establish a *prima facie* case of obviousness for Claim 39.

(H) CLAIM 40 IS PATENTABLE OVER JOAO ET AL. IN VIEW OF JONSTRÖMER AND RONEN

Appellants argued that the cited references do not teach, suggest, or otherwise render obvious the limitations of claim 40. Appeal Brief, 2/16/2009, pp. 19-20. In response, Examiner asserted:

Joao teaches the apparatus may determine if the cardholder has made a reply or response with a pre-defined time limit (col. 6, lines 53-55). The central processing computer determines if the cellular telephone owner's response was made within a pre-defined time period. If the cellular telephone owner did not reply or response within the pre-defined time limit the central processing unit will increment the unauthorized transaction count by one.

Examiner's Answer, 5/28/2009, p. 27-28. Appellants do not agree that this teaching renders obvious the claimed steps of "monitoring whether the authorized entity is still log onto the Internet" and "if the authorized entity has logged off the Internet, then not approving any request for authorizing the transaction" as claimed. Joao merely determines whether a response by a cardholder is made or received. The response is specifically related to point-of-sale transmission data. Joao, Col. 6, lines 37-47. This teaching does not render obvious the recited steps of "monitoring whether the authorized entity is still log onto the Internet" because the functionality and data involved with point-of-sale data and logging on the Internet are completely distinct.

The rejection fails to establish a *prima facie* case of obviousness for Claim 40.

(I) CLAIM 41 IS PATENTABLE OVER LANGHANS ET AL. IN VIEW OF JOAO ET AL.

Appellants argued that the cited references do not teach, suggest, or otherwise render obvious the limitations of claim 41. Appeal Brief, 2/16/2009, pp. 20-22. In particular,

Serial No. 09/714,018
Reply to Examiner's Answer dated May 28, 2009
Page 19 of 21

Appellants argued, *inter alia*, that the teachings of the Langhans reference at Col. 5, lines 2-9 — "...as opposed to the prior art system shown in FIG. 1, which requires either cash advances ahead of time or requisitions and purchase orders subsequent to the time of actual purchase" — is explicitly limited to scenarios where purchase orders are provided subsequent to the time of actual purchase. This plainly does not teach or suggest the limitations of the present claim which, in contrast, only authorizes a purchase request if purchase order information already received from an Online business matches the predetermined purchase order information. Requiring a purchase order after the time of actual purchase would not operate with the framework of claim 41, and one skilled in the art would not attempt to so modify this teaching of Langhans to achieve the elements of Claim 41 because it would destroy the intended functionality thereof.

In response, Examiner asserted:

Langhans discloses a company's purchasing control system with a credit card authorization system to produce real-time purchasing authorization and control system. The software and databases are structured to provide an automated electronic implementation of company limits and business approval processes, with a hierarchical structure, while approving or disapproving purchase by employees in real-time at the time of purchase. (Col. 2, lines 29-37) Langhans further discloses a company to group merchant category in order to limit purchases to those merchant types which would be need by a particular department or individual (col. 2, lines 40-43). An approved vendor list feature provides companies with the capability to create an approved vendor list to restrict and consolidate spending to specific merchants. Based on a comparison of the vendor data stored in an electronic approved vendor list and the merchant information transmitted from the point-of-sale in the authorization request, a purchase will be approved if the merchant data in the authorization request matches vendor information on the approved vendor list, or it will be declined if there is no match. (Col. 2, lines 49-58) Langhans also discloses requisition and purchase orders subsequent to the time of actual purchase (col. 5 lines 2-3). The Examiner cites Joao for teaching the Internet and password.

Examiner's Answer, 5/28/2009, p. 29-31.

Examiner's discussion of merchant categories and approved vendors list falls short. Claim 41 plainly recites "providing a predetermined purchase order information about a transaction" and "comparing the predetermined purchase order information with the actual

Serial No. 09/714,018
Reply to Examiner's Answer dated May 28, 2009
Page 20 of 21

purchase order information." Not only are merchant categories and approved vendor lists different from the recited purchase order information, but they also lack the specificity required by purchase order information and therefore do not render these limitations obvious.

The rejection fails to establish a *prima facie* case of obviousness for Claim 41.

(J) CLAIM 42 IS PATENTABLE OVER LANGHANS ET AL.

Appellants argued that the cited references do not teach, suggest, or otherwise render obvious "approving the transaction by the authorization agent if the non-user agrees with the transaction made by the user" and "denying the transaction by the authorization agent if the non-user does not agree with the transaction made by the user." Appeal Brief, 2/16/2009, pp. 22-24. In particular, Appellants argued, *inter alia*, that the Langhans reference fails to disclose these steps because the reference discloses an automated control system and does not teach human actions by a "user" and a "non-user." Nowhere in the Examiner's Answer (Examiner's Answer, 5/28/2009, p. 31-33) does the Examiner discuss Appellants assertion, explain why it is not correct, or assert that Langhans actually discloses that these steps are performed by a user or non-user.

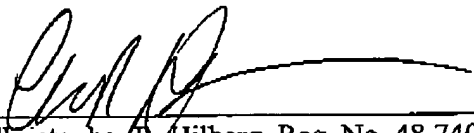
Langhans fails to teach each and every claim limitation, in as complete detail, as recited in Claim 42 as is required for a 35 U.S.C. §102 rejection.

Serial No. 09/714,018
Reply to Examiner's Answer dated May 28, 2009
Page 21 of 21

(4) CONCLUSION

This Reply Brief is being submitted within the time period specified in 37 C.F.R. §41.41 with no applicable extensions of time. Therefore, it is believed that no fees are required; however, if it is determined that fees are required the Commissioner is hereby authorized to charge any necessary fees, and to credit any such fees or overpayment, to Deposit Account No. 50-1901 (Reference: 18822-11).

Respectfully submitted,

By 
Christopher R. Hilberg, Reg. No. 48,740
Customer No. 34205
Oppenheimer Wolff & Donnelly LLP
45 South Seventh Street, Suite 3300
Minneapolis, Minnesota 55402
Telephone: 612.607.7237
Facsimile: 612.607.7100
E-mail: CHilberg@Oppenheimer.com